

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HITOSHI OHTSUKA

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Appeal No. 96-0499  
Application 07/891,671<sup>1</sup>

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HEARD: December 7, 1998

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Before HAIRSTON, JERRY SMITH, and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 13, 15-18, 21 and 23-27, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for stabilizing power consumption in a fluorescent lamp. The impedance of a

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<sup>1</sup> Application for patent filed May 29, 1992. According to appellant, this application is a continuation of Application 07/339,305, filed April 17, 1989 (abandoned).

transformer secondary winding is increased by increasing the number of turns in the secondary winding while maintaining the filament voltage of the lamp substantially constant. This arrangement is said to substantially eliminate the peak current value and reduce the harmonic distortion in the operation of the lamp.

Representative claim 13 is reproduced as follows:

13. In a low power consumption stabilizer of the type which includes a primary winding, a secondary winding, a fluorescent lamp, and a rated lamp current, the improvement which comprises:

an impedance means for reducing the current in the secondary winding;

wherein the peak current value is substantially eliminated, thereby substantially reducing the harmonic distortion in the stabilizer;

wherein the filament voltage of the lamp is maintained substantially constant, thereby maintaining substantially uniform brightness of the lamp; and

wherein said secondary winding has turns, and said impedance means is an increased number of turns in the secondary winding, said increased number being in addition to the number of turns which provides the rated lamp current.

The examiner relies on the following references:

Riesland et al. (Riesland)	4,185,233	Jan. 22, 1980
Munson	4,559,479	Dec. 17, 1985

Claims 13, 15-18, 21 and 23-27 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness the examiner offers Riesland in view of Munson.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 13, 15-18, 21 and 23-27. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 6]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejection against independent claim 13 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ

459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to representative, independent claim 13, the examiner cites Riesland as teaching a fluorescent lamp in which a transformer secondary winding acts to reduce the lamp current in the secondary circuit [rejection mailed April 14, 1994]. The examiner notes that Riesland has no teaching about maintaining the filament voltage of the lamps substantially constant, however, the examiner cites Munson as teaching this condition [Id. at pages 2-3]. The examiner also recognizes that neither of the references teaches the claimed feature of increasing the number of turns of the secondary winding for reducing the current in the secondary winding. The examiner attempts to show that the laws of physics dictate that increasing the number of turns in a secondary winding would have the same effect as the reduction of the power

voltage in Riesland [Id. at pages 3-4]. The examiner concludes that it would have been obvious to reduce the number of turns in the secondary winding in view of the teachings of Riesland and Munson and the level of skill in the art.

Appellant argues that neither Riesland nor Munson teaches increasing the secondary winding turns and that the examiner has pointed to nothing in the applied prior art which supports the obviousness of this claimed limitation. Appellant also disputes the examiner's contention that the Riesland lamp as modified by Munson would inherently have the advantages of eliminating peak current and harmonic distortion as recited in claim 13. Appellant also argues that the teachings of Riesland and Munson are not properly combinable because Riesland suggests reducing the voltage in the lamp circuit while Munson advocates maintaining a constant voltage across the lamp filament. We basically agree with all of appellant's arguments.

We agree with appellant that there is basically no motivation to modify the lamp of Riesland with the constant voltage of Munson in the absence of an improper attempt to reconstruct appellant's claimed invention in hindsight. We also agree with the argument that there is no suggestion in the references to increase the number of secondary turns as recited in claim 13. The examiner's attempt to demonstrate that appellant's invention is in accordance with the laws of physics misses the point of 35 U.S.C. § 103. Of course the invention complies with the applicable laws of physics. There is no teaching within the applied references, however, that the result achieved by appellant should be accomplished in the manner specifically claimed by

appellant. The suggestion to increase the number of turns in the secondary winding and to maintain the filament voltage substantially constant comes only from appellant's own disclosure. Therefore, the examiner's rejection of the claims based on Riesland and Munson is improper.

Since the examiner has not established a persuasive case for the obviousness of the claims on appeal, we need not consider appellant's evidence of secondary considerations of nonobviousness in the form of a declaration by the inventor Ohtsuka. We do note, however, that the examiner's treatment of this declaration is completely unacceptable. The examiner's complete response to the properly filed declaration is to state that the examiner "has evaluated the Declaration of Hitoshi Ohtsuka[]and had found the evidence of commercial success not convincing" [paper mailed March 25, 1997]. The examiner offers no analysis in support of this finding. For purposes of our consideration of this record, the examiner's bare statement that the declaration is not convincing is the same as if the declaration had not been considered at all by the examiner. The examiner must consider secondary evidence of nonobviousness and provide us with a record upon which the examiner's findings can be evaluated. As noted above, however, we need not consider the secondary evidence of nonobviousness in this case.

For all the reasons discussed above, we do not sustain the examiner's rejection of the claims under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 13, 15-18, 21 and 23-27 is reversed.

REVERSED

Appeal No. 96-0499  
Application 07/891,671

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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